

### REMARKS

This responds to the Office Action mailed on July 24, 2007.

Claims 1-7, 9-19, 21-29, and 31-36 are pending in this application.

#### §103 Rejection of the Claims

Claims 1-4, 7, 9, 13-16, 19, 21, 23-26, 29, 31, and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyden et al. (U.S. Publication No. 2003/0036964A1), hereinafter “Boyden”, in view of Linden et al. (U.S. 6,266,649), hereinafter “Linden”.

Applicants respectfully submit that the Office Action did not make out a *prima facie* case of obviousness in connection with any of the above rejections because even if combined, the cited references fail to teach or suggest all of the elements of Applicant’s claimed invention.

The references when combined must teach or suggest all the claim elements. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Linden discloses a recommendation service that recommends items to individual users based on a set of items that are known to be of interest to the user. See Abstract. The service retrieves “similar items lists corresponding to items already known to be of interest to the user, and then appropriately combines these lists to generate a list of recommended items.” See Col 3 lines 7-10. The similar items lists that are used for the generation of the list of recommended items are “previously-generated table[s] or other mapping structure[s] which map[] individual items to list of ‘similar’ items.” See Col 2 lines 39-42. The list of recommended items is presented to a potential buyer in hopes that the buyer will select an additional item from the list for purchase. See FIG. 6, Col 1 lines 22 and Col 15 lines 53-62. The generated list of recommended items in Linden is therefore a proposed list of items for a buyer to purchase.

Applicant’s claimed invention does not claim generating a proposed list, nor does Applicant’s claimed invention claim a proposed list of items for a buyer to purchase. In contrast, Applicant’s claim invention generates a proposed listing for a user (e.g., a seller) that may ultimately be posted in a database. The proposed listing once posted offers a good or service to another (e.g., a buyer or a bidder).

Boyden, as previously acknowledged by the Examiner, does not disclose that a proposed listing is generated for presentation to a user, this proposed listing including listing data from the selected similar listing. (Emphasis Added). Thus, even combining the teachings of Boyden and Lynden, there is no disclosure of generating a proposed listing that includes listing data from a selected similar listing, the selected similar listing having been selected by a user from a plurality of similar listings located in a database of listing data.

In conclusion, Applicants reaffirm the position that Lynden and Boyden, when combined, do not teach or suggest all of the claim elements of independent claim 1, and accordingly respectfully request that the rejection under 35 U.S.C. §103(a) be withdrawn.

Claims 5-6, 17-18 and 27-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyden in view of Linden and further in view of Erdelyi (U.S. 6,631,522).

Applicants submit that a dependent claim incorporates each of the claim elements of the independent claim from which it properly depends, and more. Applicants assert for the reasons stated in the prior section, that Boyden does not teach or suggest<sup>1</sup> all of the claim elements of the pending claims and the Office Action's proposed combination with Linden and Erdelyi does not cure the defect. Therefore, Applicants respectfully request withdrawal of the §103(a) rejection and allowance of pending claims.

Claims 10, 22 and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyden in view of Linden and further in view of Maze et al. (U.S. 6,216,264), hereinafter “Maze”.

Applicants submit that a dependent claim incorporates each of the claim elements of the independent claim from which it properly depends, and more. Applicants assert for the reasons stated in the prior section, that Boyden does not teach or suggest all of the claim elements of the pending claims and the Office Action's proposed combination with Linden and Maze does not cure the defect. Therefore, Applicants respectfully request withdrawal of the §103(a) rejection and allowance of pending claims.

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<sup>1</sup> The references when combined must teach or suggest all the claim elements. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Claims 11-12 and 33-34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyden in view of Linden and further in view of Ortega et al. (U.S. 6,144,958), hereinafter “Ortega”.

Applicants submit that a dependent claim incorporates each of the claim elements of the independent claim from which it properly depends, and more. Applicants assert for the reasons stated in the prior section, that Boyden does not teach or suggest all of the claim elements of the pending claims and the Office Action's proposed combination with Linden and Ortega does not cure the defect. Therefore, Applicants respectfully request withdrawal of the §103(a) rejection and allowance of pending claims.

Claim 36 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyden in view of Linden and further in view of Bezos et al. (U.S. 6,029,141), hereinafter “Bezos”.

Applicants submit that a dependent claim incorporates each of the claim elements of the independent claim from which it properly depends, and more. Applicants assert for the reasons stated in the prior section, that Boyden does not teach or suggest all of the claim elements of the pending claims and the Office Action's proposed combination with Linden and Bezos does not cure the defect. Therefore, Applicants respectfully request withdrawal of the §103(a) rejection and allowance of pending claims.

### **CONCLUSION**

Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at 636-681-1324 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

### **Reservation of Rights**

In the interest of clarity and brevity, Applicant may not have addressed every assertion made in the Office Action. Applicant's silence regarding any such assertion does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.116 – EXPEDITED PROCEDURE

Serial Number: 10/648,125

Filing Date: August 25, 2003

Title: METHOD AND SYSTEM TO GENERATE A LISTING IN A NETWORK-BASED COMMERCE SYSTEM

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Dkt: 2043.102US1

Respectfully submitted,

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Date October 30, 2007

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop RCE, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 30 day of October 2007.

Peter Rebuffoni  
Name

Peter Re  
Signature